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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/573,066

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Ulrike Wachendorff-Neumann

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EXAMINER

PIHONAK, SARAH

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/573,066	Applicant(s) WACHENDORFF-NEUMANN ET AL.	
	Examiner SARAH PIHONAK	Art Unit 1627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,13,14,17 and 18 is/are pending in the application.
 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4 and 17 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/30/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application is a national stage entry of PCT/EP04/10830, filed on 9/28/2004.

Priority

This application claims foreign priority to Application No. 103-47-090.5, filed on 10/10/2003.

Response to Remarks

1. In the response filed on 4/30/2010, Applicants have added new claims 17 and 18, and amended claim 4 to cite a weight ratio range of claimed carboxamide and triazoles of 20:1 to 1:20.
2. Applicant's arguments filed 4/30/2010 have been fully considered but they are not persuasive. The Applicants have argued that the claims would not have been prima facie obvious to one of ordinary skill in the art, at the time of the invention, over Dunkel et. al., because Dunkel et. al. does not teach that the claimed carboxamide can be combined with propiconazole, epoxiconazole, prothioconazole, tebuconazole, or bitertanol in the claimed ratio from 20:1 to 1:20. Therefore, the Applicants have asserted, as Dunkel et. al. does not teach explicitly that the combination is synergistic or the claimed weight ratio, the instant claims are non-obvious over the prior art. While this argument has been fully considered, it is not found persuasive. Dunkel et. al. teaches that N-(3,4-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide is an effective agent for protecting crops and plants from microorganisms, which can be mixed together with other fungicidal agents such as bitertanol, epoxiconazole, prothioconazole, propiconazole, and tebuconazole. Dunkel et.

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al. also teaches that the combination can result in a synergistic effect; therefore, it would have been prima facie obvious to one of ordinary skill in the art, at the time of the invention, to prepare a combination of N-(3,4-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide with bitertanol, epoxiconazole, prothioconazole, propiconazole, or tebuconazole, to provide enhanced protection towards phytopathogenic microorganisms. While Dunkel et. al. does not explicitly teach the claimed ratio of 20:1 to 1:20, it would have been considered routine and obvious for one of ordinary skill in the art to establish a weight ratio range of carboxamide and triazole, for an optimum fungicidal benefit. The Applicants have argued that Dunkel et. al. teaches that the claimed carboxamide can be combined with many possible compounds, and that the examiner's statement that it would have been obvious to combine the claimed carboxamide with the claimed triazoles is hindsight. The examiner respectfully disagrees. Dunkel et. al. clearly teaches that N-(3,4-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide can be combined with other fungicidal agents, with explicit teaching of bitertanol, epoxiconazole, prothioconazole, propiconazole, or tebuconazole. Dunkel et. al. also teaches that these combinations can result in a synergistic fungicidal effect; therefore, one of ordinary skill in the art would have expected that the combination of N-(3,4-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide with bitertanol, epoxiconazole, prothioconazole, propiconazole, or tebuconazole would have resulted in enhanced crop protection towards phytopathogenic microorganisms.

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The Applicants have argued that the claimed invention presents unexpected results over the prior art, as the claimed weight percent ratio of N-(3,4-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide with bitertanol, epoxiconazole, prothioconazole, propiconazole, or tebuconazole results in a synergistic combination. While these results have been considered, they are not fully commensurate in scope with the claimed invention. It is acknowledged that the specification shows synergy between N-(3,4-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide and prothioconazole, epoxiconazole, propiconazole, tebuconazole, and bitertanol, when the weight ratio of carboxamide to triazole is 1:1. However, amended claims 4 and new claim 17 are directed to the weight ratio of carboxamide to triazole ranging from 20:1 to 1:20; the unexpected synergy shown by the specification is only supportive for the weight ratio of 1:1. Therefore, the unexpected results are not fully commensurate in scope with the claims. Claim 17 is a dependent claim of claim 4, and is drawn to the synergistic ratio of carboxamide to triazole; however, a specific ratio is not cited in this claim, and hence it reads on the claimed ratio of claim 4, of 20:1 to 1:20. Therefore, the rejection under 35 USC 103(a) was proper and is maintained, for reasons of record. Accordingly, this action is made FINAL. For convenience, this rejection will be reiterated below, with slight modification to account for new claim 17. Claim 18, which is directed to the combination of the claimed carboxamide and the claimed triazoles in a ratio of 1:1, is free of the prior art, as the Applicants have established that synergy exists at this specific ratio.

Claims 13-14 were previously withdrawn from consideration, due to the restriction requirement.

3. Claims 4, 17, and 18 were examined.
4. Claims 4 and 17 are rejected.
5. Claim 18 is objected to.

Claim Rejections-35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunkel et. al., DE 10215292 patent application. For convenience, the English language equivalent of DE 10215292, CA Patent Application No. 2476462, will be referenced in this office action (all of previous record).

Claims 4 and 17 are drawn to a composition comprised of the compound N-(3',4'-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide, and at least one triazole selected from propiconazole, epoxiconazole, prothioconazole, tebuconazole, or bitertanol, in a ratio of 20:1 to 1:20 of carboxamide to triazole. Claim 17 is a dependent claim of claim 4, and is drawn to the synergistic ratio of carboxamide to triazole; however, a specific ratio is not cited in this claim, and hence it reads on the claimed ratio of claim 4, of 20:1 to 1:20.

Dunkel et. al. teaches carboxamide compounds as pesticidal agents effective for crop protection (Abstract; p. 1, lines 4-6, and lines 13-22; p. 20, lines 25-27). Dunkel et. al. teaches the claimed carboxamide compound, N-(3',4'-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide (p. 52, Table C, compound 11). Dunkel et. al. teaches the formulation of N-(3',4'-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide with carriers,

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extenders, and solvents (p. 25, line 7-p. 26, line 2). Additionally, Dunkel et. al. teaches that N-(3',4'-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide can be combined in a mixture with other known fungicides or insecticides, and, in many cases, a synergistic effect is observed (p. 26, lines 18-23). Particularly, it is taught that the combination of N-(3',4'-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide with other known insecticides or fungicides can broaden crop protection and prevent the development of resistance (p. 26, lines 18-23). Dunkel et. al. teaches that suitable fungicides to be mixed together with N-(3',4'-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide include bitertanol (p. 26, lines 25 and 32), epoxiconazole (p. 27, line 10), prothioconazole (p. 27, lines 31-32), propiconazole (p. 27, line 31), and tebuconazole (p. 28, line 4).

Dunkel et. al. teaches that N-(3',4'-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide is an effective agent for protecting crops from many different microorganisms, and that N-(3',4'-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide can be mixed together with other fungicidal agents such as propiconazole, epoxiconazole, prothioconazole, tebuconazole, and bitertanol to provide a synergistic effect. As such, it would have been prima facie obvious to one of ordinary skill in the art, at the time of the invention, to combine N-(3',4'-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide with the claimed triazoles to obtain a composition to protect crops from pests, fungi, and many other microorganisms. Dunkel et. al. does not

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explicitly teach that N-(3',4'-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide is combined with the claimed triazole compounds in a ratio from 20:1 to 1:20; however, it would have been considered routine for one of ordinary skill in the art to determine optimum weight ratio ranges of N-(3',4'-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide to triazole compounds for an enhanced pesticidal and fungicidal effect. As the development of optimum working ranges would have been considered routine to one of ordinary skill in the art, it would have been prima facie obvious, at the time of the invention, to establish a weight ratio range of N-(3',4'-dichloro-5-fluoro-1,1-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide to the claimed triazole compounds between 20:1 and 1:20.

Claim Objections

10. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Information Disclosure Statement

11. The information disclosure statement (IDS) submitted on 4/30/2010 was filed after the mailing date of the non-final action on 12/30/2009. The submission is in

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compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

13. No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARAH PIHONAK whose telephone number is (571)270-7710. The examiner can normally be reached on Monday-Thursday 8:00 AM - 6:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571)272-0629. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.P.

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1627